REMARKS

The present application relates to hybrid maize plant and seed 33R77. Claims 5-43 have been canceled. Claims 44-71 has been added. No new matter has been added by the present amendment. Applicant respectfully requests consideration of the following remarks.

Detailed Action

A. Status of the Application

Applicant acknowledges the objection of claims 6, 12, 16, 25, and 29 as withdrawn in light of the claim amendments. The rejection of claims 1-32 under the judicially created doctrine of obviousness-type double patenting is acknowledged as withdrawn. The rejection of claims 1-32 under 35 U.S.C. § 112, first paragraph, are also acknowledged as withdrawn.

B. Specification

Applicant submits the Deposit section on page 49 has been amended in order to properly include both the hybrid maize plant 33R77 and the inbred parents GE515419 and GE567914 within the Deposit paragraph. The changes do not add new matter as there is literal support for the minor changes on pages 7 in the originally filed specification. The specification has now been amended to correct these minor changes.

In addition, Applicant respectfully submits that the actual ATCC deposit of the two inbred plants will be delayed until the receipt of notice that the application is otherwise in condition for allowance, in compliance under 37 C.F.R. §§ 1.801-1.809. Once such notice is received, an ATCC deposit will be made, and the specification will be amended to contain the accession number of the deposit, the date of the deposit, a description of the deposited biological material sufficient to specifically identify it and to permit examination and the name and address of the depository. The claims will also be amended to recite the ATCC deposit number. Applicant submits that at least 2,500 seeds of hybrid maize plant 33R77 and the inbred parents GE515419 and GE567914 will be deposited with the ATCC. Applicant further asserts that the deposits will be made without restriction.

C. Newly Submitted Claims

Applicant acknowledges the addition of new claims 44 through 71 as specifically stated by the claims faxed by Examiner David Fox on November 15, 2002 and the new sample claim

submitted by Supervisory Patent Examiner Amy Nelson via e-mail on August 7, 2003. The new claims do not add new matter as there is support for the claims in the originally filed specification. Support for the specific items noted in the claims faxed by Examiner Fox can be found within the specification for *Bacillus thuringiensis* on page 42; for imidazolinone, sulfonylurea, glyphosate, glufosinate, L-phosphinothricin, triazine, and benzonitrile on pages 44-45; for phytase on page 45; and for stearyl-ACP desaturase, fructosyltransferase, levansucrase, alpha-amylase, invertase and starch branching enzyme on pages 45-46.

Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 6, 8, 11, 12-15, 19, 21, 24-28, 32 remain and claims 33-43 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, for the reasons of record stated in the Office Action mailed July 3, 2002.

Although not acceding to the Examiner's rejection, in order to expedite prosecution Applicant has canceled claims 6, 8, 11, 12-15, 19, 21, 24-28, 32, and 33-43, thereby rendering this rejection moot.

In light of the above amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 11-19, 24-32 remain and claims 9, 10, 22, 23, 33-43 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reasons of record stated in the Office Action mailed July 3, 2002.

Although not acceding to the Examiner's rejection, to expedite prosecution Applicant has canceled claims 9-19 and 22-43, thereby rendering this rejection moot. Applicant has added new claims 44-71 as specifically stated by the claims faxed by Examiner David Fox on November 15, 2002 and the new sample claim submitted by Supervisory Patent Examiner Amy Nelson via e-

mail on August 7, 2003. The new claims do not add new matter as there is support for the claims in the originally filed specification as described *supra*.

Claims 33-35 stand rejected under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains or with which it is most nearly connected, to make and/or use the invention.

Applicant respectfully traverses this rejection. Applicant herein submits the Deposits section has been amended in order to properly include both the hybrid maize plant 33R77 and the inbred parents GE515419 and GE567914 within the Deposit paragraph on page 49. The changes do not add new matter as there is literal support for the minor changes on page 7 in the originally filed specification.

In addition Applicant submits that the actual ATCC deposit will be delayed until receipt of notice that the application is otherwise in condition for allowance. As provided in 37 C.F.R. §§ 1.801-1.809, Applicant wishes to reiterate they will refrain from deposit of hybrid maize plant 33R77 and the inbred parents GE515419 and GE567914 until allowable subject matter is indicated. Once such notice is received, an ATCC deposit will be made, and the specification will be amended to contain the accession number of the deposit, the date of the deposit, description of the deposited biological materials sufficient to specifically identify and to permit examination and the name and address of the depository. The claims will also be amended to recite the proper ATCC deposit numbers. The Applicant provides assurance that:

a) during the pendency of this application access to the invention will be afforded to the Commissioner upon request;

b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;

c) the deposit will be maintained in a public depository for a period of thirty years, or five years after the last request for the enforceable life of the patent, whichever is longer;

d) a test of the viability of the biological material at the time of deposit will be conducted (see 37 C.F.R. § 1.807); and

e) the deposit will be replaced if it should ever become inviable.

Therefore, Applicant submits at least 2500 seeds of hybrid maize plant 33R77 and the inbred parents GE515419 and GE567914 will be deposited with the ATCC. Nevertheless, in order to expedite prosecution claims 5-43 have been canceled and new claims 44-71, have been added as disclosed *supra*. Applicant would like to reiterate that a patent application "need not teach, and preferably omits, what is well known in the art." *Hybritech Inc. v. Monoclonal Antibodies Inc.*, 802 F.2d 1367, 231 U.S.P.Q. 81 (Fed. Cir. 1986); MPEP § 601.

Claims 11, 15, 19, 24, 28, 40, and 41 stand rejected under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains or with which it is most nearly connected, to make and/or use the invention.

Applicant respectfully traverses this rejection. The Applicant has provided assurance that at least 2500 seeds of hybrid maize plant 33R77 and the inbred parents GE515419 and GE567914 will be deposited with the ATCC. In view of this assurance, the rejection under 35 U.S.C. § 112, first paragraph, should be removed. (MPEP § 2411.02). Applicant submits in order to expedite prosecution claims 11, 15, 19, 24, 28, 40, and 41 have been canceled and new claims 44-71, have been added as disclosed *supra*, making the rejection moot. For the reasons aforementioned, it is respectfully submitted that Applicants' claims are sufficiently described and enabled by the specification.

In light of the above amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections to claims 9-19 and 22-43 under 35 U.S.C. § 112, first paragraph.

Issues Under 35 U.S.C. § 102/103

Claims 11, 15, 19, 24, 28, 31 and 32 remain rejected and claims 37, 40, and 41 stand rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Whitaker (U.S. Patent 6,107,551).

Applicant has canceled claims 11, 15, 19, 24, 28, 31, 32 and claims 37, 40, and 41, thereby alleviating this rejection. Applicant acknowledges the addition of new claims 44 through 71, as specifically stated by the claims faxed by Examiner David Fox on November 15, 2002 and the new sample claim submitted by Supervisory Patent Examiner Amy Nelson via e-mail on

August 7, 2003. The new claims do not add new matter as there is support for the claims in the originally filed specification. Further, Applicant submits *In re Thorpe*, states that "a product by process claim may be properly rejected over prior art teaching the same product produced by a different process", as noted by the Examiner. *In re Thorpe*, 227 U.S.P.Q. 964, 966 (Fed. Cir. 1985). However, Applicant submits that this is not the same product physiologically or morphologically as the cited prior art as can be evidenced by one skilled in the art through analysis of the data tables in each. In addition, it is impermissible to use hindsight reconstruction and the benefit of Applicant's disclosure to pick among pieces which are present in the art; there must be some suggestion to make the combination and an expectation of success. *In re Vaeck*, 20 U.S.P.Q.2d 1434 (Fed. Cir. 1991). Moreover, Applicant claims a method of making a plant which did not previously exist. Pursuant to the recent Federal Circuit decision, *Elan Pharmaceuticals, Inc. v. Mayo Foundation for Medical Education & Research*, 304 F.3d 1221, (Fed. Cir. 2002), "a novel patented product is not 'anticipated' if it did not previously exist." *Id.* This is the case whether or not the process for making the new product is generally known. *Id.* The invention 33R77 has not previously existed as it is the result of crossing two maize inbred lines GE515419 and GE567914 therefore Applicant strongly asserts that neither the suggestion of the claimed unique invention of the present application nor the expectation of success is taught for one ordinarily skilled in the art in the reference cited by the Examiner.

In light of the above, Applicant respectfully requests the Examiner withdraw the rejection under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Whitaker (U.S. Patent 6,107,551).

Summary

Applicant acknowledges that claims 1-5, 7, and 20 are allowed.

Applicant has amended the claims as suggested by Examiner David Fox and Supervisory Patent Examiner Amy Nelson as allowable. Applicant submits the claims place the application in condition for allowance and comply with all requirements of form set forth in previous office actions.

Conclusion

In conclusion, Applicant submits in light of the above amendments and remarks, the claims as amended are in a condition for allowance, and reconsideration is respectfully requested. If it is felt that it would aid in prosecution, the Examiner is invited to contact the undersigned at the number indicated to discuss any outstanding issues.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,

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